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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|------------------|
| 09/465,708 | 12/17/1999 | FUMIKO SEMBA | FUJI-16.863 | 9208 |
| 26304 | 7590 | 07/27/2005 | EXAMINER | |
| KATTEN MUCHIN ROSENMAN LLP | | | AL AUBADI, RASHA S | |
| 575 MADISON AVENUE | | | ART UNIT | |
| NEW YORK, NY 10022-2585 | | | PAPER NUMBER | |
| | | | 2642 | |

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/465,708

Applicant(s)

SEMBA ET AL.

Examiner

Rasha S. AL-Aubaidi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/17/1999</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Amendment***

1. The request filed on 06/09/2005 for an RCE is acceptable.
2. Applicant's amendment filed on July 09, 2005 has been entered. Claims 14-16 have been amended. No further claims have been canceled. No claims have been added. Claims 14-16 are still pending in this application, with claims 14 and 8 being independent.

Claim Rejections - 35 USC § 103

3. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al (US Patent 6,574,216) hereinafter '216 in view of Farris (US PAT # 6,064,653) hereinafter '653.

Regarding claim 14, Farris '216 specifically teaches the switching of a telephone call in progress, and currently connected via the Internet (50, Fig. 3) to another non-internet network (PSTN 10, Fig. 3) in order to **improve voice quality**. See abstract, col. 9, lines 35-58 and col. 11, lines 22-58. The claimed "exchange" reads on the combination of SSP 13 and Internet module 92. Pressing the "*" digit on the caller's telephone 11 during an economical Internet call will switch the call from Internet 50 to the PSTN 10 to improve the voice quality. The Internet may be selected when the caller dials a code such as *82 or based on the caller's routing criteria in his/her CPR (col. 9, lines 35-58).

Farris '216 differs from the claims only in the way the caller signals his/her desire to switch from the Internet to PSTN during a telephone call via the Internet. In Farris '216, the caller signals his/her desire to switch from the Internet to PSTN by dialing the "*" digit which is detected by Internet module 92 during a telephone call via the Internet. However, in the claimed invention, the caller signals his/her desire to switch from the Internet to PSTN by pushing a button after a "quick" on-hook/flash operation during a telephone call via the Internet.

The difference is merely in the specific way the caller signals the exchange ("SSP 13 and module 92"). The use of on-hook/flash operation to signal an exchange is old and well known. For example, a quick or temporary on-hook or flash operation maybe used to establish a conference call, to answer a call in response to a call waiting tone ... etc. Thus, obviously one of ordinary skill in the art may use any type of signal ("*" in Farris, or pushing a button after a flash operation in the claims) in order to accomplish the same exact result for the same exact purpose. Simply using another signal in Farris '216 does not rise to the level of patentability.

When the calling party in Farris '216 desires to switch the call from the Internet to the PSTN, he/she dials *82 only. The calling party does not dial the telephone number of the called party when he/she decides to switch from the Internet to PSTN. The PSTN will inherently need the number of the called party

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to connect the calling party to the called party. Therefore, it is inherent that the "exchange" in Farris '216 will have to store the telephone number of the called party to effect the switching. In both, the claimed invention and Farris '216, the connection through the Internet has to be disconnected and a new connection through the PSTN has to be "originated"; thus "re-originating" the call between the calling and the called parties.

Farris '216 does not specifically teach disconnecting the established call connection via a second trunk from the PSTN and re-originating the call to the calling party through the Internet via a first trunk.

However, Farris '653 specifically teaches that calls, which are established via PSTN, can be re-routed from the PSTN to the data network, when the condition of the data network improves (see abstract of the invention and col. 5, lines 42-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of switching from the PSTN to data network when the condition of the data network improves, as taught by '653, into the '216 system in order to reduce the cost to the calling party by switching to the internet which is more economical than the PSTN.

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Claims 15-16 are rejected for the same reasons as discussed above with respect to claim 11.

Response to Arguments

4. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

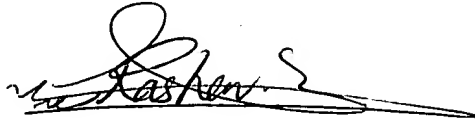
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (571) 272-7481. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar, can be reached on (571) 272-7488.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Rasha S Al-Aubaidi', with a long horizontal flourish extending to the right.

Examiner
Rasha. S Al-Aubaidi
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07/20/2005